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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,387	10/07/2005	Hideyuki Inose	482782007600	9265
25224 7590 07/13/2010 MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024				
EXAMINER				
PILKINGTON, JAMES				
ART UNIT		PAPER NUMBER		
3656				
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07/13/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,387

Applicant(s)

INOSE ET AL.

Examiner

JAMES PILKINGTON

Art Unit

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2010 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, PG PUB: US 2002/0078792 A1, in view of Krauss, USP 4,188,833.

Kobayashi discloses a motor vehicle transfer case comprising:

- a change-direction gear set (30/31) to change a rotation direction of a driving force at a right angle, the change-direction gear set (30/31) comprising a first change-direction gear (30) and a second change-direction gear (31)
- an input shaft (31a) rotating coaxially and integrally with the second change-direction gear (31)
- an output shaft (35) disposed in parallel with the input shaft (31a)

- a power transmission (32/33) device including a gear set (32 and 33 are gears) configured to couple the input shaft (31a) with the output shaft (35);
- a pair of first bearings (ball bearing and one of the roller bearings on 31a) aligned in an axial direction, the first bearings rotatably supporting the input shaft (31a), the first bearings having the power transmission device (gear 32) disposed therebetween ;
- a pair of second bearings (ball bearings on 35) aligned in an axial direction, the second bearings rotatably supporting the output shaft (35)
- a pair of third bearings (roller bearings on 26R/34) rotatably supporting the first change-direction gear (30)
- a housing member (casing) for housing the input shaft (31a), the output shaft (35), the first bearings, the second bearings, the third bearings and the power transmission device (32/33), the housing member including a main body (9 and insert around tapered bearings of shaft 31a), a first cover (to the left of 9 in Figure 1, holding differential), and a second cover (below 9 and the insert in Figure 1, structure holding 36), the main body supporting one of the first bearings, one of the second bearings and one of the third bearings, the first cover supporting the other of the third bearings (just to the right of reference character 26R), and the second cover supporting the other of the second bearings (see bearing just above 36)
- wherein the housing member is so dimensioned that a first housing chamber defined by the main body and first cover houses the first change direction

gearing (30/31) and the pair of third bearings, and a second housing chamber defined by the main body and the second cover houses the input shaft (31a), the pair of first bearings, the output shaft (35), the pair of second bearings, and the power transmission device (32/33), whereby the housing member positions the first change direction gear, the second change direction gear, the input shaft and the output shaft in place.

Kobayashi does not disclose that the main body of the housing is a single unitary body which supports one of the first bearings and one of the second bearings.

Krauss teaches a housing main body (5) which is formed of a single unitary body which supports one bearing of a first set (bearings on 20/23) and one bearing of a second set (bearings on 10) and also supporting an input shaft and an output shafts (10 and 23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobayashi and provide a housing main body which is formed as a single unitary body which supports one of the first bearings and one of the second bearings, as taught by Krauss, since substituting a multiple part body for a single part body yields the predictable result of simplifying assembly and disassembly since there is few components to handle. In addition, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Claims 8-11, 14, and 15, rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, PG PUB: US 2002/0078792 A1, in view of Hideyo, JP 59-069553 and further in view of Krauss, USP 4,188,833.

Kobayashi discloses a motor vehicle transfer case comprising:

- a change-direction gear set (30/31) to change a rotation direction of a driving force at a right angle, the change-direction gear set (30/31) comprising a first change-direction gear (30) and a second change-direction gear (31);
- a first gear (32) rotating coaxially and integrally with the second change-direction gear (31)
- a second gear (33) disposed in parallel with and engaged with the first gear (32)
- a casing (see Fig 1) housing the change-direction gear set (30/31) and the gears (32 and 33), the casing including a main body (9 and insert) which rotatably supports the change-direction gear set (30/31) and the gears (32/33), a first cover (to the left of 9) for covering the main body so as to house the first change-direction gearing in the casing, and a second cover (holding 36) for covering the main body (9) so as to house the gears, whereby the casing positions the first change direction gear, the second change direction gear and remaining gears
- the first change-direction gear (30) coupled with an output of a transmission of a vehicle and a seal (27) to prevent intrusion of oil in the transmission.

- a pair of bearings (above and below 32) wherein the first gear (32) is disposed between the pair of the bearings
- the first and the second change-direction gears (30 and 31) are rotatably supported by a pair of bearings receiving force in an axial direction (see Fig 1)
- the first gear (32) is disposed between a pair of bearings (one below and one of the bearings above the gear) rotatably supporting the second change-direction gear (31)

Kobayashi does not disclose a second gear engaged with the first with a third gear being arranged in parallel and engaged with the second gear and wherein the first gear is smaller in diameter than the bearings.

Hideyo teaches a change-direction gear arrangement which has a second gear (8) in parallel and engaged with a first gear (7) and a third gear (9) arranged in parallel and engaged with the second gear (8) and wherein the first gear (7) is smaller in diameter than the bearings (see Fig 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobayashi and use a three gear reduction stage and to make the first gear smaller in diameter than the bearings, as taught by Hideyo, since substituting a two gear reduction stage for a three gear reduction stage would yield the predictable result of driving the output mechanism and a changing in the gear size would result in a modified gear reduction ratio.

Kobayashi in view of Hideyo does not disclose that the main body of the housing is a single unitary body which supports one of the first bearings and one of the second bearings.

Krauss teaches a housing main body (5) which is formed of a single unitary body which supports one bearing of a first set (bearings on 20/23) and one bearing of a second set (bearings on 10) and also supporting an input shaft and an output shafts (10 and 23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobayashi in view of Hideyo and provide a housing main body which is formed as a single unitary body which supports one of the first bearings and one of the second bearings, as taught by Krauss, since substituting a multiple part body for a single part body yields the predictable result of simplifying assembly and disassembly since there is few components to handle. In addition, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, PGPUb: US 2002/0078792 A1, in view of Hideyo, JP 59-069553 and Krauss, USP 4,188,833 as applied to claim 8 above, and further in view of Palazzolo, USP 6,605,018.

Kobayashi discloses all of the claimed subject matter as applied above.

Kobayashi does not disclose a plane formed by a rotation axis of the first gear and a rotation axis of the second gear and another plane formed by the rotation axis of the second gear and a rotation axis of the third gear form an angle smaller than 180 degrees and the rotation axis of the third gear is disposed in a direction away from the rotation axis of the first change-direction gear, the second gear and the third gear are disposed offset in respective perpendicular directions relative to the a rotation axis of a power transmission member coupled with the first change-direction gear, a rotation axis of the first gear is disposed offset in a direction away from the first change-direction gear, a rotation axis of the second gear is disposed offset in a direction closer to the first change-direction gear than the rotation axis of the first gear, and a rotation axis of the third gear is disposed offset in a direction more distant from the first change-direction gear than the second gear.

Palazzolo teaches a plane formed by a rotation axis of the first gear (see at least Fig 1A and 1B item 40) and a rotation axis of the second gear (see at least Figs 1A and 1B item 38) and another plane formed by the rotation axis of the second gear (see at least Figs 1A and 1B item 38) and a rotation axis of the third gear (see at least Figs 1A and 1B item 28) form an angle smaller than 180 degrees and the rotation axis of the third gear is disposed in a direction away from the rotation axis of the first change-direction gear (see at least Figs 1A and 1B item 56), the second gear and the third gear are disposed offset in respective perpendicular directions relative to the a rotation axis of a power transmission member coupled with the first change-direction gear (see at least Fig 1B), a rotation axis of the first gear is disposed offset in a direction away from

the first change-direction gear (see at least Fig 1B), a rotation axis of the second gear is disposed offset (see at least Fig 1B) in a direction closer to the first change-direction gear than the rotation axis of the first gear, and a rotation axis of the third gear is disposed offset in a direction more distant from the first change-direction gear than the second gear (see at least Fig 1B).

It would have been obvious to one skilled in the art at the time of the invention was made to modify Kobayashi and provide a plane formed by a rotation axis of the first gear and a rotation axis of the second gear and another plane formed by the rotation axis of the second gear and a rotation axis of the third gear form an angle smaller than 180 degrees and the rotation axis of the third gear is disposed in a direction away from the rotation axis of the first change-direction gear, the second gear and the third gear are disposed offset in respective perpendicular directions relative to the a rotation axis of a power transmission member coupled with the first change-direction gear, a rotation axis of the first gear is disposed offset in a direction away from the first change-direction gear, a rotation axis of the second gear is disposed offset in a direction closer to the first change-direction gear than the rotation axis of the first gear, and a rotation axis of the third gear is disposed offset in a direction more distant from the first change-direction gear than the second gear, as taught by Palazzolo, for the purpose of allowing more space additional elements (C2/L16-29).

Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, PGPUB: US 2002/0078792 A1, in view of Hideyo, JP 59-069553, and Krauss, USP 4,188,833, as applied to claim 8, and further in view of Tsukasa, JP 04-203659.

Kobayashi discloses all of the claimed subject matter as applied above.

Kobayashi does not disclose at least any one of the first change-direction gear and the second change-direction gear comprises a regulation device (see at least Fig 1 item 68) for regulating tooth contact and pressure of the change-direction gear set by changing an axial direction.

Tsukasa teaches a change-direction gear comprising a regulation device (see at least Fig 1 item 68) for regulating tooth contact and pressure of the change-direction gear set by changing an axial direction.

It would have been obvious to one skilled in the art at the time of the invention was made to modify Kobayashi with at least any one of the first change-direction gear and the second change-direction gear comprises a regulation device (see at least Fig 1 item 68) for regulating tooth contact and pressure of the change-direction gear set by changing an axial direction, as taught by Tsukasa, for the purpose of regulating a position in the axial direction of the gearing (Tsukasa abstract).

Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, PGPUB US 2002/0078792 A1, in view of Hideyo, JP 59-069553, and Krauss, USP 4,188,833, as applied to claim 8 above, and further in view of Miller, USP 4,286,481.

Kobayashi discloses all of the claimed subject matter as applied above.

Kobayashi does not disclose that the bearings are selected from the group of cylindrical roller bearings or needle roller bearings.

Miller teaches a bearings that are selected from the group of cylindrical roller bearings and needle roller bearings (see reference character 28) in a transmission system.

It would have been obvious to one skilled in the art at the time of the invention was made to modify Kobayashi and provide for the bearings being selected from a group of cylindrical roller bearings and needle roller bearings, as taught by Miller, since substituting one type of bearing for another is known in the art in order to provide a suitable bearing (e.g., ball bearings, roller bearings, thrust bearings, etc) based on the force and speed which they require to support.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, PG PUB: US 2002/0078792 A1, in view of Hideyo, JP 59-069553, Krauss, USP 4,188,833, and Miller, USP 4,286,481, as applied to claim 17 above, and further in view of Hickey et al. USP 4,283,963.

Kobayashi all of the claimed subject matter as applied above.

Kobayashi does not disclose a positioning device configured to position the roller bearings in an axial direction.

Hickey teaches a positioning device configured to position the roller bearings in an axial direction (60) for the purpose of adjusting the axial position of the bearing (C4/L23-38).

It would have been obvious to one skilled in the art at the time of the invention was made to modify Kobayashi and provide a positioning device configured to position the roller bearings in an axial direction, as taught by Hickey, for the purpose of adjust the axial position of the bearing.

Claim 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, PGPUB: US 2002/0078792 A1, in view of Hideyo, JP 59-069553, and Krauss, USP 4,188,833, as applied to claim 8 above, and further in view of Yokel, USP 3,803,934.

Kobayashi discloses all of the claimed subject matter as applied above.

Kobayashi does not disclose that one of the first-third gears are helical gears.

Yokel teaches that helical gears can be used in a power transmission system for the purpose of providing a system where the gears can be made with less under-cut and more width across the top rear side so that it can transmit higher loads (C1/L51-55).

It would have been obvious to one skilled in the art at the time of the invention was made to modify and provide helical gear teeth, as taught by Yokel, for the purpose of providing a system where the gears can be made with less under-cut and more width across the top rear side so that it can transmit higher loads.

Response to Arguments

Applicant's arguments filed June 16, 2010 have been fully considered but they are not persuasive.

Regarding claims 6 and 8, the Applicant argues that Kobayashi in view of Krauss and/or Hideyo does not meet the limitations “the housing member including a main body formed in a single unitary body,” since there is no motivation to combine the references because the prior art teaches away from a single unitary/integral body, and that the references are non-analogous art.

In response to applicant's argument that there is no suggestion to combine the references (pages 13-15), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is general knowledge to one of ordinary skill in the art that substituting a multiple part body for a single part body yields the predictable result of simplifying assembly and disassembly since there is few components to handle. It is also noted that it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

In response to applicant's argument that the prior art is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this

case, the prior art is in the field of gear casings, whether the gear casing is used in a car, boat, plane or other motorized device does not structural distinguish the gear casing and is only a recitation of intended use in the absence of any particular structure linking the transfer case to a specific device.

In response to Applicant's remarks that Kobayashi does not disclose covers since the element 10 is not an accompanying component for a housing main body, but an independent housing.

Element 10 may indeed be an independent housing, however it still performs all the required functions of a cover by sealing the main body of a transfer gear housing. The claims do not address any particular structure of the covers to distinguish over the prior art. In the absence of any particular structure, any component which acts to close off or seal a housing or casing, regardless of the size, shape or function of that component, is a cover.

Conclusion

This is a RCE of applicant's earlier Application No. 10/552387. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is (571)272-5052. The examiner can normally be reached on Monday - Friday 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES PILKINGTON/
Examiner, Art Unit 3656
7/12/10

/Thomas R. Hannon/
Primary Examiner, Art Unit 3656